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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,124	02/09/2004	Susumu Noda	39.038	2123

29453 7590 02/21/2006

JUDGE PATENT FIRM  
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JAPAN

EXAMINER
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BLEVINS, JERRY M

ART UNIT	PAPER NUMBER
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2883

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/708,124	NODA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jerry Martin Blevins	2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.  
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-11 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:  
 1. ☒ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: Lines 5 and 7 of paragraph 41, page 17, Detailed Description section, contain dimensional units for wavelength and lattice constant which are unknown. The applicants list a wavelength of 1.55  $\square$ m and a lattice constant of 0.42  $\square$ m. Although the meaning of the  $\square$ m unit is uncertain, the examiner interprets this to mean  $\mu$ m, since the correct unit apparently contains a special character.

Appropriate correction is required.

### ***Claim Objections***

Claim 10 is objected to because of the following informalities:

The claim indicates dependency from "any of claims 1," which is confusing.

Examiner interprets claim 10 to depend only from claim 1.

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application, Pre Grant Publication Number 2004/0184754 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because displacement of a low-refractive-index substance can reasonably be interpreted as a type of dimensional alteration of the low-refractive-index substance. Displacement in either one or two dimensions is an example of dimensional alteration.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being obvious over Akahane, et al, "Design of a channel drop filter by using a donor-type cavity with high-quality factor in a two-dimensional photonic crystal slab", Applied Physics Letters, March 3, 2003, pages 1341-1343, in view of Srinivasan and Painter, "Momentum space design of high-Q photonic crystal optical cavities", Optics Express, July 29, 2002, pages 670-684.

Regarding Claim 1, Akahane teaches a two-dimensional photonic crystal configured by an arrangement, in a two-dimensional lattice of points defined in a slab (page 1341, column 1, lines 1-2), of low-refractive-index substances having a small refractive index relative to the slab (page 1341, column 1, line 9 teaches that the low-refractive-index substances are air, while page 1342, column 1, line 22 teaches that the slab has a refractive index of 3.4) and being of identical dimension and shape (Figure 1), a cavity made from a point defect within the two-dimensional crystal, wherein: the point defect contains among the lattice points a plurality of three or more neighboring one another (specifically three as seen in Figure 1, L3 and T3), and in the plurality of three or more lattice points, the low-refractive-index substances are missing from the arrangement (page 1341 column 2, line 19).

Akahane does not teach that at least one of the low-refractive-index substances, that would otherwise be arranged to correspond to at least one among those lattice points being nearest the point defect, is displaced by a predetermined distance from the at least one of the lattice points nearest the point defect. However, Srinivasan teaches that the geometry of a point defect and the surrounding holes in a two-dimensional photonic crystal can be altered (page 673, section 3, line 3 and page 670, Abstract, line 6), which reasonably includes the displacement of lattice points nearest the point defect. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Srinivasan, that is to displace by a predetermined distance at least one of the lattice points nearest the point defect, to the teachings of Akahane. The motivation would have to reduce the vertical radiation loss from the photonic crystal slab (page 673, section 3, line 3 and page 670, Abstract, line 6).

Regarding Claim 2, Akahane in view of Srinivasan teaches the limitations of the base claim 1. Akahane does not teach the further limitation that at least one of the low-refractive-index substances that would otherwise be arranged to correspond to at least one among the lattice points being secondarily adjacent the point defect also is displaced by a predetermined amount from the at least one of the lattice points secondarily adjacent the point defect. However, the above reference to surrounding holes taught by Srinivasan can reasonably be interpreted as applying to secondarily adjacent lattice points, so the above obviousness rationale applies to Claim 2, as well.

Regarding Claim 3, Akahane in view of Srinivasan teaches the limitations of the base claim 1. Akahane also teaches a point defect consisting of exactly three lattice points (referenced above), which is, by definition, fewer than six lattice points.

Regarding Claim 4, Akahane in view of Srinivasan teaches the limitations of the base claim 1. Akahane does not teach that the wavelength of light that resonates in the cavity is adjustable in dependency upon the dimension and shape of the point defect. However, Srinivasan teaches that the cavity will support various resonant modes that depend on the nature of the point defect (page 673, section 3, line 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Srinivasan, that is that the resonate wavelength of the light in the cavity is adjustable depending on the dimension and shape of the point defect, to the teachings of Akahane. The motivation would have to widen the bandwidth of confined light.

Regarding Claim 5, Akahane in view of Srinivasan teaches the limitations of the base claim 1. Akahane also teaches that the plurality of lattice points which form the point defect are lined in a line segment (page 1341, Figure 1, L3).

Regarding Claim 6, Akahane in view of Srinivasan teaches the limitations of the base claim 1. Akahane also teaches that the low-refractive-index substances are filled into columns perforating the slab (page 1341, Figure 1).

Regarding Claim 7, Akahane in view of Srinivasan teaches the limitations of the base claim 1. Akahane also teaches that the lattice points of the two dimensional lattice are arrayed in a triangular lattice (page 1341, column 1, line 8).

Regarding Claim 8, Akahane in view of Srinivasan teaches the limitations of the base claim 1. Akahane also teaches that the slab has a refractive index of 2.0 or greater. (Specifically, the slab index of refraction is given as 3.4 on page 1342, column 1, line 22).

Regarding Claim 9, Akahane in view of Srinivasan teaches the limitations of the base claim 1. Akahane also teaches that the low-refractive-index substances are air (page 1341, column 1, line 9).

Regarding Claim 10, Akahane in view of Srinivasan teaches the limitations of the base claim 1 as well as a channel add/drop filter comprising at least one waveguide from a line defect within a two-dimensional photonic crystal and that the cavity is disposed adjacent the waveguide, within a separation in which an electromagnetically reciprocal effect is produced between the cavity and waveguide (page 1341, Figure 1(a)). However, Akahane does not teach the combination of the above waveguide with the cavity as set forth in claim one, but rather Akahane teaches the above waveguide adjacent to a single point defect cavity. Akahane does teach that a three-hole point defect cavity has a higher Quality factor than its one-hole counterpart (page 1342, Table 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Akahane in view of Srinivasan with the further teaching of Akahane in order to create a channel add/drop filter, as specified in Claim 10. The motivation would have been to increase the Quality factor.

Regarding Claim 11, Akahane in view of Srinivasan teaches the limitations of the base claim 10. Akahane does not teach a plurality of cavities where the cavities differ



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from one another in resonant frequency. However, Srinivasan, as mentioned above (page 673, section 3, line 3) teaches that the resonant frequency of the cavity depends on the dimension and shape of the point defect. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teaching of Srinivasan, namely that a plurality of cavities can differ from each other in resonant frequency depending on the dimension and shape of the cavity point defect, to the add/drop filter taught by Akahane in view of Srinivasan. The motivation would have been to broaden the bandwidth of the add/drop filter.

### ***Priority***

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Response to Arguments***

Applicant's arguments filed 02/03/2006 have been fully considered but they are not persuasive.

The publication date of the applied reference to Akahane et al. is March 3, 2003, which is before applicants' filing date in the United States, February 9, 2004. Since applicants cannot rely on the foreign papers to overcome this rejection (see above), the reference constitutes prior art under 102(a) and therefore can be used in a 103(a) obvious-type rejection. Note that although the reference does not antedate the U.S.

filing date by more than 1 year, the reference nonetheless qualifies as prior art under 102(a) (and therefore under 103(a)), since the inventive entity of the applied reference is not identical to that of the applicants (see MPEP 2132 III). Also note that since the applied reference qualifies as prior art under 102(a), it is not disqualified under 103(c) (see MPEP 2146[R-3]). Therefore, the applied reference to Akahane et al. clearly qualifies as prior art under 103(a).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Martin Blevins whose telephone number is 571-272-8581. The examiner can normally be reached on Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMB



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